



KNE001/135211

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Sallas, et al.

| | | | |
|---|------------|------------|------------------|
| Serial No.: | 10/812,365 | Group No.: | 3765 |
| Date Filed: | 03/22/2004 | | |
| For: Infant Pants Having Knee Pockets and Replacement Knee Pads | | Examiner: | Patel, Tajash D. |

REQUEST FOR CONTINUED EXAMINATION (RCE)
(37 C.F.R. § 1.114)

1. Applicant hereby requests continued examination, in accordance with 37 C.F.R. § 1.114, for the above identified application.

NOTE: 37 C.F.R. § 1.114 Request for continued examination.

"(a) If prosecution in an application is closed, an applicant may request continued *examination* of the application by filing a submission and the fee set forth in § 1.17(e) prior to the earliest of:

- (1) Payment of the issue fee, unless a petition under § 1.313 is granted;
- (2) Abandonment of the application; or
- (3) The filing of a notice of appeal to the U.S. Court of Appeals for the Federal Circuit under 35 U.S.C. 141, or the commencement of a civil action under 35 U.S.C. 745 or 146, unless the appeal or civil action is terminated.

(b) Prosecution in an application is closed as used in this section means that the application is under appeal, or that the last Office action is a final action (§ 1.113), a notice of allowance (§ 1.311), or an action that otherwise closes prosecution in the application.

CERTIFICATE OF MAILING/TRANSMISSION (37 C.F.R. § 1.8)

I hereby certify that this transmittal (6 pgs) and a preliminary amendment are, on the date shown below, being deposited with sufficient postage as First Class Mail, in an envelope addressed to the following: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Date: 2/2/2006

Coco H. Betancourt

Signature

Coco H. Betancourt

02/07/2006 HDESTA1 00000012 10812365

01 FC:2801
02 FC:2251

395.00 OP
60.00 OP

(c) A submission as used in this section includes, but is not limited to, an information disclosure statement, an amendment to the written *description, claims, or drawings*, new arguments, or new *evidence in* support of patentability. If reply to an Office action under 35 U.S.C. 132 is outstanding, the submission must meet the reply requirements of § 1.1-11.

(d) if an applicant timely files a submission and fee set forth in § 1.17(e), the Office will withdraw the finality of any Office action and the submission will be entered and considered. If an applicant files a request for continued examination under this section after appeal, but prior to a decision on the appeal, it will be treated as a request to withdraw the appeal and to reopen prosecution of *the application before the examiner*. An appeal brief under § 1.192 or a reply brief under § 1.193(b), or *related papers*, will not be considered a submission under this section."

NOTE: An applicant may file a submission under 37 CFR 1.114 containing only an information disclosure statement (37 CFR 1.97 and 1.98) in an application subject to a notice of allowance under 35 U.S.C. § 151. An appeal brief or a reply brief (or related papers) will not be considered a submission under 37 CFR 1.114. See 37 CFR 1.114(d). The submission, however, may consist of the arguments in a *previously filed appeal brief or reply* brief, or may simply consist of a statement that incorporates by reference the arguments in a previously filed appeal brief or reply brief. In addition, a previously filed amendment after final may satisfy this submission requirement. American Inventor's Protection Act of 1999, Question & Answer A5.

NOTE: Even though an RCE is improper (e.g., because it was filed before the prosecution is closed), an amendment submitted with the RCE will still be entered and *considered by the examiner since it was* timely filed and responsive to the non-final Office action in compliance with 37 CFR 1.111. American Inventor's Protection Act of 1999, Question & Answer A4.

WARNING: 35 U.S.C. 132 (b) and § 1.114 provide for the continued examination of an application and not examination of a continuing application). Accordingly, the Office will not permit an applicant to obtain continued examination on the basis of claims that are independent and distinct from the claims previously claimed and examined. Notice of March 10, 2000, 65 Fed Reg 14865, at 14868.

WARNING: The provisions of 37 CFR 1.114 also do not apply (1) to a provisional application; (2) an application for a utility or plant patent filed under 35 U.S.C. 111(a) before June 8, 1995; (3) an international application filed under 35 U.S.C. 363 before June 8, 1995; (4) a patent under reexamination or (5) an application for a design patent. 37 CFR § 1A 14(e).

WARNING: The PTO has pointed out why § 1.97(b) does not provide that an information disclosure statement will be considered if it is filed within three months after the date of a request for continued examination under § 1.114. The PTO explained that since an RCE filing is a reply under 35 U.S.C. 132, the applicant may be entitled to patent term adjustment if the Office does not act on an application containing a request for continued examination under § 1.114 within four months. See 35 U.S.C. 154(b)(1)(A)Cj[r]. Thus, the Office cannot delay action on RCE applications for three months to determine whether an information disclosure statement will be filed. The Office, however, is adopting provisions (§ 1.103(c)) for a limited suspension of action after the filing of a request for continued examination under § 1.114, for the applicant to obtain additional time (prior to the issuance of the next Office action) to provide an information disclosure statement (or amendments, or an affidavit or declaration) after the filing of the RCE. See, Notice of August 16, 2000, "Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule", 65 Fed. Reg., pages 50091--50105, at page 50104 (comment 11); OG: September 5, 2000, pages 13-24

WARNING: One of the time periods excluded from patent term adjustment is the time consumed by a continued examination request under 35 U.S.C. 132(b) (§ 1.114(b) (1)).

WARNING. The Office will not suspend action in an application when a reply by the applicant is outstanding. 35 U.S.C. 133 requires an applicant to "prosecute the application" within six months of an Office action (or a shorter period as set in the office action) to avoid abandonment of the application.

If an applicant files a request for continued examination but does not also provide any submission in reply to the prior Office action within the period for reply to the prior Office action, the application is abandoned by operation of law (35 U.S.C. 133).

The Office will treat a request for continued examination under § 1.114 containing a bona fide submission that is not fully responsive to the prior Office action under the practice set forth in § 1.135(c). In addition, under the limited suspension of action provisions of § 1-103(c), an applicant must still file a request for continued examination practice in compliance with § 1.114, but may obtain additional time (prior to the issuance of the next Office action) to provide an information disclosure statement, amendments, or an affidavit or declaration after the filing of the request for continued examination.

See, Notice of August 16, 2000, "Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule", 65 Fed. Reg., pages 50091-50105, at page 50102 (comment 20), OG: September 5, 2000, pages 13-241 Page 50102

WARNING: Section 1.97(b) does not provide that an information disclosure statement will be considered if it is filed within three months after the date of a request for continued examination under § 1.114.

NOTE: There is no limit to the number of times the fee for continued examination may be submitted. Notice of March 10, 2000, 65 Fed Reg 14865, at 14868.

NOTE: Unlike a continuation application, a continued examination request can utilize the mailing procedure of 37 CFR 1.8. See 37 CFR § 1.8(6)(2)(r)(A).

Continued Prosecution Request Fee \$ 395

TIME REQUEST IS BEING MADE

2. This request is being submitted {check appropriate items} below:

- i. ☒ Prior to abandonment of the application
- ii. ☐ Payment of the issue fee
 - ☐ Prior to payment of the issue fee
 - ☐ Issue fee has been paid but a petition under § 1.313 has been granted
- iii. ☐ Prior to a decision on appeal to the Board of Patent Appeals & Interferences
 - ☐ A notice is being separately sent to the Board of Patent Appeals & Interferences that this Request for Continued Examination is being filed.

NOTE: if such a notice is not sent to the Board then may refuse to vacate a decision rendered after the filing of the RCE but before recognition by the Office of the RCE request under § 7.114.

- iv. ☐ Appeal to the U.S. Court of Appeals of the Federal Circuit under 35 U.S.C. 145 or
 - ☐ Commencement of a civil action under 35 U.S.C. 146
 - ☐ Prior to the filing of such appeal or commencement of civil action
 - ☐ Such appeal or commencement of civil action has been terminated ENCLOSURES

3. Enclosed herewith is/are:

WARNING: If reply to a final or non-final Office action under 35 U.S.C. 132 is outstanding, the submission must meet the reply requirements of § 1.117. 37 C.F.R. § 1.114(b).

- ☐ An information disclosure (37 C.F.R. § 1.98)
 - ☐ Form PTO-1449 (PTOISB108A and 08B) An amendment
- ☐ New Arguments
- ☐ New Evidence in support of patentability
- ☒ Other: An Amendment

Continued Prosecution Request Fee \$ 395

FEE FOR REQUEST (37 C.F.R. § 1.17(e)).

4. This application is on behalf of:

- ☒ Small Entity (and status is still as small entity) **\$395.00**
☐ Other than a small entity **\$790.00**

FEE FOR CLAIMS

NOTE: "The fee for continued examination under § 1.114 (§ 1.17(e)) does not include additional claims fee (cf. 1.53 (d){3} (k))."
See Notice of March 10, 2004, 65 Fed Reg 14865, at 14868.

37 CFR 1.53(d)(3): "The filing fee for a continued prosecution application filed under this paragraph is:

(i) *The basic* filing fee as set forth in § 1.16; and

Any additional § 7.16 fee due *based on the* number of claims remaining in the application after entry of any amendment accompanying the request for an application under *this paragraph* and entry of any amendments under § 1.116 unentered in the prior application which applicant has *requested* to be entered in the continued prosecution application."

5. The fee for claims (37 C.F.R. § 1.16(b)-(d)) has been calculated as shown below:

| Claims Remaining After Amendment | Highest No. Previously Paid For | Extra Present | Rate | Added Fee |
|--|---------------------------------------|------------------|-----------|-----------|
| Total: 11 | 20 | 0 | \$25/50 | \$0 |
| Independent: 3 | 3 | 0 | \$100/200 | \$0 |
| First Presentation of Multiple Dependent Claims: | | | \$180/360 | \$0 |
| Total Additional Fees: | | | | \$0 |

WARNING: See 37 C. FR. § 1.116.

(complete (a) or (b), as applicable)

(a) ☒ No additional fee is required.

OR

(b) ☐ Total additional fee required is \$ _____

EXTENSION OF TIME

(If an extension of time is appropriate complete (a) or (b), as applicable)

6. The proceedings herein are for a patent application, and the provisions of 37 C.F.R. 136(a) apply.

37 C.F.R. § 1.704(b) "...an applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of three months that are taken to reply to any notice or action by the Office making any rejection, objection, argument, or other request, measuring such three-month period from the date the notice or action was mailed or given to the applicant, in which case the period of adjustment set forth in § 1, 703 shall be reduced by the number of days, if any, beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying the applicant of the rejection, objection, argument, or other request and ending on the date the reply was filed. the period, or shortened statutory period, for reply that is set in the Office action or notice has no effect on the three-month period set forth in this paragraph."

(a) ☒ Applicant petitions for an extension of time, the fees for which are set out in 37 C.F.R. § 1.17(a)(1)-(4), for the total number of months checked below:

| Extension for (months) | Large Entity | Small Entity |
|---|--------------|--------------|
| <input checked="" type="checkbox"/> one month | \$ 120.00 | \$ 60.00 |
| <input type="checkbox"/> two months | \$ 450.00 | \$ 225.00 |
| <input type="checkbox"/> three months | \$1,020.00 | \$ 510.00 |
| <input type="checkbox"/> four months | \$1,590.00 | \$ 795.00 |
| <input type="checkbox"/> five months | \$2,160.00 | \$1,080.00 |

Fee: \$ 60.00

If an additional extension of time is required, please consider this a petition therefor.

(check and complete the next item, if applicable)

☐ An extension for ____ months has already been secured, and the fee paid therefor of \$ ____ is deducted from the total fee due for the total months of extension now requested.

Extension fee due with this request \$ 60.00

OR

(b) ☐ Applicant believes that no extension of time is required. However, this is a conditional petition and authorization to pay the necessary fees to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

TOTAL FEE(S) DUE

WARNING. The fee for continued examination under § 1.114 may not be deferred.

7. The total fee(s) due is/are:

| | |
|---|--------|
| Continued Prosecution Fee (§ 1.17(e))..... | \$ 395 |
| Fee(s) for additional claims (if any) (§ 1.16(b)-(d)) | \$ |
| Extension of time fee (if any) (§ 1.17(a)(1)-(4)) | \$ 60 |

Total Fee(s) Due.....\$ 455

PAYMENT OF FEE(S) DUE

8. Please pay the fee(s) for this continued examination application as follows:

☒ Check is attached for the sum of \$ 455.00

☐ Charge Account 50-0897 (KNE001/135211) the sum of

☐ Charge Credit Card the sum of

(Credit Card Payment Form (PTO-2038) attached)

Please charge any required additional fee(s) for § 1.17(e), § 1.16(b)-(d) and/or § 1.17(a)(1)-(4) to

☒ Account 50-0897 (KNE001/135211)

☐ Credit Card (Credit Card Payment Form (PTO-2038) attached).

INVENTORSHIP

NOTE Any change of inventors must be via the procedure set forth in 37 CFR § 1.48. See Notice of March 10, 2000, 65 Fed Reg 14865, at 14868

9. This application as amended names as inventors:

☒ the same inventors as previously designated for the claims.

☐ fewer than the inventors previously designated and a statement accompanies this request for the deletion of the name or names of the person or persons who are not inventors of the invention now being claimed.

☐ a person not named previously as an inventor and a petition under 37 C.F.R. § 1.48 is/has separately:

☐ being filed ☐ been filed

DEFERRAL OF EXAMINATION

10. ☐ A request for deferral of examination accompanies this request for continued examination.

Respectfully submitted,



Brett T. Cooke
Reg. No. 55,836
Andrews & Kurth, L.L.P.
600 Travis, Suite 4200
Houston, Texas 77002
713/220-3813 (office)
713/220-4285 (facsimile)
Cust. No. 23,444

Date: February 1, 2006